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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VOLKER HENNIGE,
CHRISTSIAN HYING and GERHARD HORPEL

Appeal 2011-007022
Application 10/501,713
Technology Center 1700

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and JEFFREY T. SMITH, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1, 3-5, 7-12, 14-22, 24-28, 30-38, 40, 46-51 and 53-59 in the Office Action mailed April 16, 2010. We have jurisdiction. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2010).

An oral hearing was held May 9, 2012.

We reverse the decision of the Primary Examiner.

Appellants request review of the grounds of rejection under 35 U.S.C. § 103(a) advanced on appeal by the Examiner: claims 1, 3-5, 7-12, 14-22,

24-28, 30, 31, 33, 40, 46-51 and 53-59 over Penth (US 6,309,545 B1) and Bishop (US 5,639,555), and claims 32, 34-38 and 49 over Penth, Bishop and Sassa (US 5,324,579). App. Br. 6; Ans. 12, 15.

Appellants also request review of provisional grounds of rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting as unpatentable over the claims of seven copending Applications taken in view of Penth and Bishop. App. Br. 7-8; Ans. 3, 5, 6, 7, 8, 9. We find that six of the copending Applications have matured into patents. Appellants rely on the same position advanced with respect to Penth and Bishop in the grounds of rejection under § 103(a). App. Br. 13.

Opinion

The dispositive issue raised by the positions of the parties is whether, on this record, the Examiner has established that Penth would have led one of ordinary skill in the art to a membrane comprising, among other things, a substrate material of, among other things, polyamide fibers that has "a porosity of more than 50%" as specified in representative claim 1. App. Br. 14, Cl. Appdx. Ans. 12, 14, 16-17; App. B. 8-9; Reply Br. 3-4. The Examiner does not contest Appellants' position that Penth would not have specifically disclosed a substrate material that has the claimed porosity and that the substrate material in Penth's Example 2.1 has a porosity of 0.3%. App. Br. 8-9; Ans. 18. The Examiner submits Penth would have taught that the substrate material can have a gap or pore range of 0.02 to 500 μm, and that the pore size can be controlled to control the permeability of the membranes made with the substrate material, leading one of ordinary skill in the art to select the desired porosity of the substrate material by routine experimentation. Ans. 12, 14, 16, citing col. 3, ll. 1-10 and 39-60, col. 3,

l. 61 to col. 4, l. 10. The Examiner contends that Penth's pore or mesh size range of up to 500 μm would be sufficient to provide a porosity of more than 50% as claimed. Ans. 16, citing Penth col. 3, ll. 1-10, col. 4, ll. 11-16.

We agree with Appellants that the Examiner has not established that Penth would have led one of ordinary skill in the art to the claimed membrane comprising a substrate material which can be a polyamide fiber having a porosity of more than 50%. Indeed, as Appellants contend, the Examiner has not correlated Penth's pore size range for the substrate material with the porosity of that material. Reply Br. 3-4. In this respect, we find that as Appellants point out, the disclosure of a pore or mesh size range of up to 500 μm at column 4, lines 1-16, of Penth, on which the Examiner relies, refers to substrate materials which include woven metal or alloy fibers, expanded metal, sintered metal or sintered glass, and not polyamide fibers disclosed at column 3, line 67, of the reference. Reply Br. 4; Ans. 12, 16.

Accordingly, in the absence of a prima facie case of obviousness, we reverse the grounds of rejection of the appealed claims under 35 U.S.C. § 103(a) and under the judicially created doctrine of obviousness-type double patenting.

The Primary Examiner's decision is reversed.

REVERSED

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